

REMARKS

Claims 1-24 are presently pending in the application, of which claims 1, 12, 18 and 22 are independent.

Claim Rejections - 35 U.S.C. §103(a)

Claims 1-10 are rejected under 35 U.S.C. §103(a) as being unpatentable over Special Edition Using Microsoft Outlook 2000 ("Special Edition") in view of United States Patent No.: 6,643,694 ("Chernin"). Applicant respectfully traverses the rejection for the following reasons.

Independent claim 1 is directed to a method performed in an electronic device executing *an email application*. The method includes the steps of providing *a search feature* for use with the email application, and providing *a plurality of storage locations* for storing email messages. The storage locations are accessible by the email application. The method also includes the steps of searching a designated active storage location with the search feature and *retrieving data indicated by a user-input parameter from selected email messages in the active storage location*. A new document is created containing data retrieved from the messages. Claims 2-10 depend upon claim 1.

Applicant respectfully submits that the cited prior art references fail to teach or suggest all of the elements of claim 1. Applicant submits that Special Edition and Chernin fail to teach *retrieving data indicated by the user-input parameter from selected email messages in the active storage location*, as recited in claim 1.

The Examiner recognizes in the Office Action that Special Edition does not teach this limitation. Chernin is cited by the Examiner to provide teachings for this limitation. Applicant respectfully disagrees with the Examiner's position and submits that Chernin does not teach this limitation.

Chernin teaches integrating an e-mail server (36) with a proxy server (26) and a DHCP (Dynamic Host Configuration Protocol) server (14). Chernin also teaches searching the email

archives (34) in the email server (36). Chernin further teaches that if a text string to be searched is entered, the search feature searches through email archives (34) in the email server (36) for the text string and displays the search results. Chernin teaches the automatic search of the email archives (34) in the email server (36) for certain text strings (e.g., bomb, sex, and the like) on a periodic basis (e.g., daily, weekly, or the like). In particular, Chernin is provided to prompt appropriate officials (e.g., a manager, security director, or the like) to investigate the corresponding e-mail message. See Chernin, column 35, lines 12-19.

In contrast, the claimed invention provides a search feature for searching the email messages of an individual email user. The search feature of the claimed invention works with an email application executed in the electronic device of the individual email user. The email application accesses storage locations and stores the email messages of the individual email user. The search feature searches the storage location and retrieves data from email messages in the storage location. Chernin teaches at most searching and retrieving data from *the email archives in the email server*. Chernin does not teach retrieving data from selected email messages in the storage location that stores *the email messages of the individual email user*.

In light of the above arguments, Applicant respectfully submits that Special Edition and Chernin fail to teach or suggest all of the limitations of claim 1. Claims 2-10, which depend upon claim 1, are not rendered obvious over the cited prior art references. Applicant therefore requests the Examiner to reconsider and withdraw the rejection of claims 1-10 under 35 U.S.C. §103(a), and pass the claims to allowance.

Claim Rejections - 35 U.S.C. §103(a)

Claim 11 is rejected under 35 U.S.C. §103(a) as being unpatentable over Special Edition Using Microsoft Outlook 2000 (“Special Edition”) in view of United States Patent No.: 6,643,694 (“Chernin”), and further in view of U.S. Patent No.: 6,243,694 (“Jamali”). Applicant respectfully traverses the rejection for the following reasons.

Claim 11 depends upon claim 1 and includes the additional element of forwarding the new document to a user after deleting email data that is duplicative.

Applicant respectfully submits that the cited prior art references fail to teach or suggest all of the limitations of the claimed invention. Applicant submits that Special Edition, Chernin and Jamali fail to teach the step of retrieving data indicated by the user-input parameter from selected email messages in the active storage location, as recited in claim 1. Jamali teaches adaptive recognition of documents using layout attributes. Jamali does not teach anything about email search features.

Additionally, Applicant respectfully submits that Special Edition, Chernin and Jamali fail to teach forwarding the new document to a user after deleting email data that is duplicative, as recited in claim 11. Jamali is cited by the Examiner to provide teachings for this limitation. Jamali teaches deleting duplicative *images* to conserve storage space. See Jamali, column 2, lines 24-41. In contrast, the claimed invention recites deleting email data, which is generally a *text* data. In the claimed invention, duplicative searched data is deleted to simplify the data presentation to a user. See the pending application, page 3, lines 1-4. Jamali does not teach forwarding the new document to a user after deleting email data that is duplicative to simplify the data presentation to a user.

In light of the above arguments, Applicant submits that Special Edition, Chernin and Jamali fail to teach or suggest all of the limitations of claim 11. Applicant respectfully requests the Examiner to reconsider and withdraw the rejection of claim 11 under 35 U.S.C. §103(a), and pass the claim to allowance.

Claim Rejections - 35 U.S.C. §103(a)

Claims 12-13, 15-16 and 18-19 are rejected under 35 U.S.C. §103(a) as being unpatentable over Special Edition Using Microsoft Outlook 2000 ("Special Edition") in view of United States Patent No.: 6,643,694 ("Chernin"), and further in view of U.S. Patent No.: 6,216,122 ("Elson"). Applicant respectfully traverses the rejection for the following reasons.

Independent claim 12 is directed to a method performed in an electronic device executing an email application. The method includes the steps of providing a plurality of storage locations

for storing email messages, and providing a search feature for use with the email application. The storage locations are accessible by the email application. The method also includes the step of searching the storage locations with the search feature. *The search feature copies less than all the data in selected email messages in the storage locations and the copied data is inserted into a new document.* Claims 13 and 15-16 depend upon claim 12. Claim 18 is a medium claim that recites similar limitations. Claim 19 depends upon claim 18.

Applicant respectfully submits that the cited prior art references fail to teach or suggest all of the elements of claims 12 and 18. Applicant submits that Special Edition, Chernin and Elson fail to teach the step of searching the storage locations with the search feature, the search feature copying less than all the data in selected email messages, as recited in claims 12 and 18.

The Examiner recognizes in the Office Action that Special Edition does not teach this limitation. Chernin is cited by the Examiner to provide teachings for this limitation. Applicant respectfully disagrees with the Examiner's position and submits that Chernin does not teach this limitation.

The claimed invention provides a search feature for searching the email messages of an individual email user. The search feature of the claimed invention works with an email application executed in the electronic device of the individual email user. The email application accesses storage locations and stores the email messages of the individual email user. The search feature searches the storage locations and copies less than all of the data in the selected email messages in the storage locations. Chernin teaches at most searching *the email archives in the email server*. Chernin does not teach copying less than all of the data in the selected email messages in the storage locations that store *the email messages of the individual email user*.

Elson is cited by the Examiner to provide teaching for the plurality of storage locations. Elson, however, does not teach copying less than all of the data in the selected email messages in the storage locations, as recited in claims 12 and 18.

In light of the above arguments, Applicant respectfully submits that Special Edition, Chernin and Elson fail to teach or suggest all of the limitations of claims 12 and 18. Claims 13,

15-16 and 19, which depend upon one of claims 12 and 18, are not rendered obvious over the cited prior art references. Applicant therefore requests the Examiner to reconsider and withdraw the rejection of claims 12-13, 15-16 and 18-19 under 35 U.S.C. §103(a), and pass the claims to allowance.

Claim Rejections - 35 U.S.C. §103(a)

Claims 14 and 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Special Edition Using Microsoft Outlook 2000 ("Special Edition") in view of United States Patent No.: 6,643,694 ("Chernin"), and further in view of U.S. Patent No.: 6,216,122 ("Elson"), and further in view of U.S. Patent Application Publication No.: 2003/0131006 ("Monahan"). Applicant respectfully traverses the rejection for the following reasons.

Claims 14 and 20 depend upon claims 12 and 18, respectively. Claims 14 and 20 includes the additional limitation that the new document is Hypertext Markup Language (HTML) format.

Applicant respectfully submits that the cited prior art references fail to teach or suggest all of the limitations of claims 12 and 18. Applicant submits that Special Edition, Chernin, Elson and Mohanan fail to teach searching the storage locations with the search feature, the search feature copying less than all the data in selected email messages, as recited in claims 12 and 18. Mohanan is cited by the Examiner to provide teaching for the Hypertext Markup Language (HTML) format document. Mohanan, however, does not teach does not teach searching the storage locations with the search feature, the search feature copying less than all the data in selected email messages, as recited in claims 12 and 18.

In light of the above arguments, Applicant respectfully submits that Special Edition, Chernin, Elson and Mohanan fail to teach or suggest all of the limitations of claims 12 and 18. Claims 14 and 20, which depend upon claims 12 and 18, respectively, are not rendered obvious over the cited prior art references. Applicant therefore requests the Examiner to reconsider and withdraw the rejection of claims 14 and 20 under 35 U.S.C. §103(a), and pass the claim to allowance.

Claim Rejections - 35 U.S.C. §103(a)

Claims 17 and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Special Edition Using Microsoft Outlook 2000 (“Special Edition”) in view of United States Patent No.: 6,643,694 (“Chernin”), and further in view of U.S. Patent No.: 6,216,122 (“Elson”), and further in view of U.S. Patent No.: 6,243,694 (“Jamali”). Applicant respectfully traverses the rejection for the following reasons.

Claims 17 and 21 depend upon claims 12 and 18, respectively. Claims 17 and 21 includes the additional limitation that the new document is forwarded to a user after deleting email data that is duplicative.

Applicant respectfully submits that the cited prior art references fail to teach or suggest all of the limitations of claims 12 and 18. Applicant submits that Special Edition, Chernin, Elson and Jamali fail to teach the step of searching the storage locations with the search feature, the search feature copying less than all the data in selected email messages, as recited in claims 12 and 18. Jamali teaches adaptive recognition of documents using layout attributes. Jamali does not teach email search features.

Additionally, Applicant submits that Special Edition, Chernin, Elson and Jamali fail to teach the step of forwarding the new document to a user after deleting email data that is duplicative, as recited in claims 17 and 21. Jamali is cited by the Examiner to provide teachings for this limitation. Jamali teaches deleting duplicative *images* to conserve storage space. See Jamali, column 2, lines 24-41. In contrast, the claimed invention recites deleting duplicative email data, which is generally a *text* data. In the claimed invention, duplicative data is deleted to simplify the data presentation to a user. See the pending application, page 3, lines 1-4. Jamali does not teach forwarding the new document to a user after deleting email data that is duplicative to simplify the data presentation to a user.

In light of the above arguments, Applicant respectfully submits that Special Edition, Chernin, Elson and Jamali fail to teach or suggest all of the limitations of claims 17 and 21.

Applicant therefore requests the Examiner to reconsider and withdraw the rejection of claims 17 and 21 under 35 U.S.C. §103(a), and pass the claim to allowance.

Claim Rejections - 35 U.S.C. §103(a)

Claims 22-23 are rejected under 35 U.S.C. §103(a) as being unpatentable over Special Edition Using Microsoft Outlook 2000 (“Special Edition”) in view of U.S. Patent No.: 6,216,122 (“Elson”), and further in view of U.S. Patent Application Publication No.: 2002/0138474 (“Lee”). Applicant respectfully traverses the rejection for the following reasons.

Independent claim 22 is directed to a method performed in an electronic device executing an email application. The method includes the steps of providing a plurality of storage locations for storing email messages, and providing a search feature for use with the email application. The method also includes the step of searching the storage locations with the search feature. *The search feature copies less than all the data in selected email messages and the copied data is inserted into a new document.* The method further includes the steps of *caching a copy of the new document, and cross-referencing the new document copy and the search request.* Claims 23 depends upon claim 22.

Applicant respectfully submits that the cited prior art references fail to teach or suggest all of the elements of claim 22. Applicant submits that Special Edition, Elson and Lee fail to teach the step of searching the storage locations with the search feature, the search feature copying less than all the data in selected email messages, as recited in claim 22.

The Examiner notes in the Office Action that Special Edition teaches this limitation on page 1. Applicant respectfully disagrees with the Examiner’s position and submits that Special Edition does not teach this limitation. Special Edition teaches accessing the advanced find feature provided in Microsoft Outlook 2000. Special Edition teaches on page 1 the advanced find dialog box for entering inputs. Special Edition, however, does not teach copying less than all of the data in the selected email messages in the storage locations that store the email messages of the individual email user, as recited in claim 22.

Additionally, Applicant submits that Special Edition and Chernin fail to teach caching a copy of the new document, and cross-referencing the new document copy and the search request, as recited in claim 22. The Examiner recognizes in the Office Action that Special Edition does not teach this limitation. Lee is cited by the Examiner to provide teachings for this limitation. Applicant respectfully disagrees with the Examiner's position and submits that Lee does not teach this limitation.

Lee teaches searching and organizing intellectual property (IP). Lee teaches a search and organization server that includes one or more modules to create and process search queries to be run on local or remote database systems. In paragraph [0025], Lee teaches that search results, the underlying documents listed in the search results, as well as the search criteria itself may be saved (in local or remote memory units).

In contrast, the claimed invention provides a search feature for searching the email messages of an individual email user. The search feature searches the storage location and copies less than all of the data in the selected email messages in the storage location. The copy of the new document is cached and cross-referenced to the search request. Lee does not teach caching the search result of *the email messages of the individual email user*. Lee does not teach cross referencing the search request and the search result of *the email messages of the individual email user*.

Elson is cited by the Examiner to provide teaching for the plurality of storage locations. Elson, however, does not teach caching a copy of the new document, and cross-referencing the new document copy and the search request, as recited in claim 22.

In light of the above arguments, Applicant respectfully submits that Special Edition and Elson and Lee fail to teach or suggest all of the limitations of claim 22. Claim 23, which depends upon claim 22, is not rendered obvious over the cited prior art references. Applicant therefore requests the Examiner to reconsider and withdraw the rejection of claims 22-23 under 35 U.S.C. §103(a), and pass the claims to allowance.

Claim Rejections - 35 U.S.C. §103(a)

Claim 24 are rejected under 35 U.S.C. §103(a) as being unpatentable over Special Edition Using Microsoft Outlook 2000 (“Special Edition”) in view of U.S. Patent No.: 6,216,122 (“Elson”), and further in view of U.S. Patent Application Publication No.: 2002/0138474 (“Lee”) ”), and further in view of U.S. Patent Application Publication No.: 2003/0002488 (“Hyakutake”). Applicant respectfully traverses the rejection for the following reasons.

Claim 24 depends upon claim 22. Claim 24 adds the limitation that the cached document is forwarded to a user.

Applicant respectfully submits that Special Edition, Elson, Lee and Hyakutake fail to teach caching a copy of the new document, and cross-referencing the new document copy and the search request, as recited in claim 22. Hyakutake is cited by the Examiner to provide teachings for the limitation added in claim 24. Hyakutake teaches information transmission and information display. Hyakutake also teaches the display of Internet content information or related content information multiplexed in a television broadcast. Hyakutake, however, does not teach caching a copy of the new document, and cross-referencing the new document copy and the search request, as recited in claim 22.

In light of the above arguments, Applicant submits that Special Edition, Elson, Lee and fail to teach or suggest all of the limitations of claim 22. Claim 24, which depends upon claim 22, is not rendered obvious over the cited prior art references. Applicant respectfully requests the Examiner to reconsider and withdraw the rejection of claim 24 under 35 U.S.C. §103(a), and pass the claim to allowance.

Conclusion

In view of the above amendment, applicant believes the pending application is in condition for allowance.

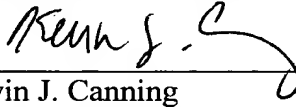
Application No.: 09/867920
Group Art Unit: 2141

Docket No.: SMQ-052/P5699

Applicant believes no fee is due with this statement. However, if a fee is due, please charge our Deposit Account No.: 12-0080, under Order No.: SMQ-052 from which the undersigned is authorized to draw.

Dated: June 29, 2005

Respectfully submitted,

By 
Kevin J. Canning
Registration No.: 35,470
LAHIVE & COCKFIELD, LLP
28 State Street
Boston, Massachusetts 02109
(617) 227-7400
(617) 742-4214 (Fax)
Attorney/Agent For Applicant